

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed April 20, 2005. Upon entry of the amendments in this response, claims 21 – 40 remain pending. In particular, Applicants add claims 21 – 40 and cancel claims 1 – 20 without prejudice, waiver, or disclaimer. Applicants cancel these claims merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Amendments to the Drawings

Applicants amend FIG. 1 to remove “Headend 102.” Applicants submit that this is amendment is cosmetic in nature and thus should not be construed to raise prosecution history estoppel. Applicants further submit that no new matter is added.

II. Amendments to the Written Description

Applicants amend the written description as noted above. Applicants submit that these amendments are merely to correct clerical errors, and are thus cosmetic in nature. Applicants therefore submit that these amendments should not be construed to raise prosecution history estoppel, and that no new matter is added.

III. Claims 1 – 20 are Canceled

The Office Action indicates that claims 1 – 20 stand rejected as allegedly being anticipated or obvious in view of International Publication Number WO 92/22983 (“*Browne*”). Applicants respectfully traverse this rejection on the grounds that *Browne* does not disclose, teach, or suggest all of the claimed elements. However, Applicants cancel claims 1 – 20 and therefore consider this rejection moot.

IV. Office Action’s Findings of Inherency

A. Canceled Claim 1 is Not Inherent

In rejecting now canceled claim 1, the Office Action states:

The claimed limitation of “wherein the recording commands indicate to the processor that at least one selected type of information has been selected for storage by the storage device, and wherein, upon reception of a recording command from the user, the command transmits that a recording command to the processor, in response to which the at least one selected type of information is provided to the storage device, and wherein other non-selected types of information are not provided to the storage device for recording” is met by that discussed above. The reference discloses that the user selects the program to be recorded; consequently, it is inherent that non-selected types of information are not provided to the storage device for recording. (OA p. 3, beginning line 16).

Applicants respectfully traverse the finding of inherency. It is well established that “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or

possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In Re Anthony J. Robertson*, 98-1270 (Fed. Cir. 1999).

Applicants assert that a “system for receiving information and for recording at least a portion of the information... wherein the recording commands indicate to the processor that at least one selected type of information has been selected for storage by the storage device, and wherein, upon reception of a recording command from the user, the command transmits that a recording command to the processor, in response to which the at least one selected type of information is provided to the storage device, and wherein other non-selected types of information are not provided to the storage device for recording” (canceled claim 1), is not inherent in the art. In accordance with *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999), Applicants therefore traverse the inherency finding of canceled claim 1.

B. Canceled Claim 11 is Not Inherent

In rejecting now canceled claim 11, the Office Action states:

In regard to claim 11, Browne discloses that the system is used in conjunction with cable television broadcasting system, which inherently has a headend for generating multiple types of information and is a distribution system for delivering the information. (OA p. 5, beginning line 4).

Applicants respectfully traverse the finding of inherency. It is well established that “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or

possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In Re Anthony J. Robertson*, 98-1270 (Fed. Cir. 1999).

Applicants assert that a “system for receiving information and for recording at least a portion of the information... wherein the broadband communications system includes: a headend for generating the multiple types of information... [and] a distribution system for delivering the information” (canceled claim 11), is not inherent in the art. In accordance with *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999), Applicants therefore traverse the inherency finding of canceled claim 11.

C. Canceled Claim 13 is Not Inherent

In rejecting now canceled claim 13, the Office Action states:

In regard to claim 13, Brown[e] et al.. discloses a large capacity, random access, multi-source audio and video recorder player which is capable of receiving a plurality of simultaneous input signals and which allows a user to view and/or record selected ones of the plurality of input signals. “The multi-source recorder player 100 preferably has multiple input connections, each of which may receive an input signal 101a – 101f from air and ground based broadcast sources, cable feeds, or digital distribution sources” (page 6). Browne discloses that the system is used in conjunction with a cable television broadcasting system, which inherently has a headend for generating multiple types of information and is a distribution system for delivering the information. (OA p. 5, beginning line 20).

Applicants respectfully traverse the finding of inherency. It is well established that “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or

possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In Re Anthony J. Robertson*, 98-1270 (Fed. Cir. 1999).

Applicants assert that a “broadband communications system... comprising a headend for generating the transport stream from multiple input sources; [and] a distribution system for delivering the transport stream...” (canceled claim 13), is not inherent in the art. In accordance with *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999), Applicants therefore traverse the inherency finding of canceled claim 13.

Additionally, in rejecting now canceled claim 13, the Office Action states:

The claimed limitation of “wherein the recording commands indicate to the processor that at least one of the selected streams has been selected for storage by the storage device, and wherein, upon reception of a recording command from the user, the command unit transmits the recording command to the processor, in response to which the at least one of the selected streams is provided to the storage device, and wherein the other non-selected streams are not provided to the storage device for recording” [i]s met by that discussed above. The reference discloses that the user selects the program to be recorded; consequently, it is inherent that non-selected types of information are not provided to the storage device for recording. (OA p. 7, beginning line 15).

Applicants respectfully traverse the finding of inherency. It is well established that “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In Re Anthony J. Robertson*, 98-1270 (Fed. Cir. 1999).

Applicants assert that a “broadband communications system... wherein the recording commands indicate to the processor that at least one of the selected streams has been selected for

storage by the storage device, and wherein, upon reception of a recording command from the user, the command unit transmits the recording command to the processor, in response to which the at least one of the selected streams is provided to the storage device, and wherein the other non-selected streams are not provided to the storage device for recording,” (canceled claim 13), is not inherent in the art. In accordance with *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999), Applicants therefore traverse the inherency finding of canceled claim 13.

C. Canceled Claim 15 is Not Inherent

In rejecting now canceled claim 15, the Office Action states:

In regard to claim 15... Browne discloses providing a menu to the user that is indicative to the available stream where the user can choose at least one of the streams for recording as can be seen in Figure 6. As to the limitation of the transport streams including packet identifiers, packet identifiers are inherent to the MPEG specification. (OA p. 10, beginning line 17).

Applicants respectfully traverse the finding of inherency. It is well established that “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In Re Anthony J. Robertson*, 98-1270 (Fed. Cir. 1999).

Applicants assert that a “broadband communications system... comprising a headend for generating the transport stream from multiple input sources; [and] a distribution system for delivering the transport stream...” (canceled claim 15), is not inherent in the art. In accordance

with *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999), Applicants therefore traverse the inherency finding of canceled claim 15.

V. Office Action's Findings of Official Notice

A. Applicants Traverse the Finding of Official Notice of Canceled Claim 3

In rejecting now canceled claim 3, the Office Action states:

In regard to claim 3, the reference discloses a remote control for providing [a] recording... command from the user. The reference fails to explicitly disclose that the remote control is an infrared remote control. The Examiner takes Official Notice that it is notoriously well known in the art to have a remote control that is an infrared remote control so as to prove a convenient and flexible way of conveying [a] user command to a system. (OA p. 9, beginning line 3).

Applicants respectfully traverse this finding of Official Notice and submit that the subject matter noted above should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions, as required.

Applicants assert that a system for receiving information and for recording at least a portion of the information “wherein the command unit is an infrared remote control, and wherein the infrared remote control provides the recording command as an infrared control signal when associated buttons on the remote control are actuated” (canceled claim 3), is not well known and expected in the art. Applicants therefore traverse the Official Notice finding of canceled claim 3.

B. Applicants Traverse the Finding of Official Notice of Canceled Claim 5

In rejecting now canceled claim 5, the Office Action states:

In regard to claim 5, Browne discloses recording compressed digital signals. The reference fails to explicitly disclose that the compressed digital signals are MPEG transport streams. The examiner takes Official Notice that it is notoriously well known in that art to [compress] digital signals that are MPEG transport streams so as to provide interoperability. (OA p. 9, beginning line 10).

Applicants respectfully traverse this finding of Official Notice and submit that the subject matter noted above should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions, as required.

Applicants assert that a system for receiving information and for recording at least a portion of the information “wherein the transport stream is an MPEG transport stream” (canceled claim 5), is not well known and expected in the art. Applicants therefore traverse the Official Notice finding of canceled claim 5.

C. Applicants Traverse the Finding of Official Notice of Canceled Claim 6

In rejecting now canceled claim 6, the Office Action states:

In regard to claim 6, input 101g and input demodulator 113g meets the limitation of a decoder for decoding and providing the stream to the presentation device. The reference fails to explicitly disclose that the compressed digital signals are MPEG transport streams. The Examiner takes Official Notice that it is notoriously well known in that art to [compress] digital signals that are MPEG transport streams so as to provide interoperability. (OA p. 9, beginning line 17).

Applicants respectfully traverse this finding of Official Notice and submit that the subject matter noted above should not be considered well known since the Office Action does not

include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions, as required.

Applicants assert that a system for receiving information and for recording at least a portion of the information “wherein the processor and the storage device are included within a set-top receiver, the set top receiver including: a demodulator for demultiplexing the incoming MPEG transport stream; and a decoder for decoding and providing at least one of the audio streams, video streams, and data streams to the presentation device” (canceled claim 6), is not well known and expected in the art. Applicants therefore traverse the Official Notice finding of canceled claim 6.

D. Applicants Traverse the Finding of Official Notice of Canceled Claim 14

In rejecting now canceled claim 14, the Office Action states:

In regard to claim 14, Browne discloses recording compressed digital signals. The reference fails to explicitly disclose that the compressed digital signals are MPEG transport streams. The examiner takes Official Notice that it is notoriously well known in that art to [compress] digital signals that are MPEG transport streams so as to provide interoperability. (OA p. 10, beginning line 9).

Applicants respectfully traverse this finding of Official Notice and submit that the subject matter noted above should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions, as required.

Applicants assert that a broadband communications system “wherein the transport stream is an MPEG transport stream” (canceled claim 14), is not well known and expected in the art. Applicants therefore traverse the Official Notice finding of canceled claim 14.

VI. New Claims are Allowable in View of the Cited Art

A. New Claim 21 is Allowable in View of the Cited Art

Applicant submits that new claim 21 is allowable in view of the cited art for at least the reason that the cited art fails to disclose, teach, or suggest at least a “selectable recording device for providing recording options to a user, comprising... a processor configured to provide a user option to select at least one desired subset of content streams for a particular program event for recording, wherein the subset excludes at least one available content stream” as recited in new claim 21.

B. New Claim 28 is Allowable in View of the Cited Art

Applicant submits that new claim 28 is allowable in view of the cited art for at least the reason that the cited art fails to disclose, teach, or suggest at least a “method for providing recording options to a user, comprising... providing a user option to select at least one desired subset of content streams for a particular program event for recording, wherein the subset excludes at least one available content stream” as recited in new claim 28.

C. New Claim 33 is Allowable in View of the Cited Art

Applicant submits that new claim 33 is allowable in view of the cited art for at least the reason that the cited art fails to disclose, teach, or suggest at least a system for providing recording options to a user, comprising a control system configured to provide a user option to select at least one desired subset of content streams for a particular program event, wherein the subset excludes at least one available content stream...” as recited in new claim 33.

D. Claims 22 – 27, 29 – 33, and 35 – 40 are Patentable Over the Cited Art

In addition, dependent claims 22 – 27 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 21. Dependent claims 29 – 33 are believed to be allowable for at least the reason that they depend from allowable independent claim 28. Dependent claims 35 – 40 are believed to be allowable for at least the reason that these claims depend from claim 34. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 21 – 40 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Further, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



Jeffrey R. Kuester, Reg. No. 34,367

THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500